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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,801	09/15/2003	Eric G. Hull	427600600064	9503

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EXAMINER
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ESTRADA, ANGEL R

ART UNIT	PAPER NUMBER
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2831

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/662,801	Applicant(s) HULL ET AL.	
	Examiner Angel R. Estrada	Art Unit 2831	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.  
     4a) Of the above claim(s) 1-5 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 8-13 and 15 is/are rejected.
- 7) ☒ Claim(s) 7 and 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                      | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                             | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9/15/03</u> | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to an electrical bracket having a fastening structure, an extension and a stabilizer, classified in class 174, subclass 53.
  - II. Claims 6-15, drawn to an electrical bracket having a fastening tab and a fastener support to mount the bracket in a side mounted position, classified in class 174, subclass 58.
  - III. Claim 16, drawn to an electrical bracket having an end attachment and a first and second side attachment, classified in class 174, subclass 57.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the fastener support configured to capture a stud penetrating fastener that fastens said bracket to the stud when said frame is in a side mounted position is not required. The subcombination has separate utility such as an electrical bracket that can be fastened to a stud in two different positions.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

2. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a first and second side attachment means for mounting the frame in a first and second side mounted position respectively is not required. The subcombination has separate utility such as an electrical bracket that can be fastened to a stud in three different positions.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III, restriction for examination purposes as indicated is proper.

3. Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because a second side attachment means

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for mounting the frame a second side mounted position is not required. The subcombination has separate utility such as an electrical bracket that can be fastened to a stud in three different positions.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group III, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mitchell Rose on January 23, 2004 a provisional election was made without traverse to prosecute the invention of Group II, claims 6-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-5 and 16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract

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on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc (*lines 2 and 3 "comprises"*)

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6, 8, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bourassa (US 5,579,939).

Regarding claim 6, Bourassa discloses an electrical bracket (10) for mounting an electrical device to a wall stud (40), said bracket (10) comprising: a rectangular frame (see figure 1) having first (12) and second (16) opposite end walls, first (14) and second (18) opposite side walls (see figure 1), and a front opening (20) surrounded by said end walls and side walls for inserting an electrical device into said frame (see figure 1), said frame (10) having an end-mounted position (see figure 4) in which said first end wall

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(12) faces a side surface of the stud (see figure 4); a fastening tab (54) extending from said first end wall (12) in a direction away from said second end wall (16) and configured to be fastened to a front surface of the stud (see figure 4) when said frame (10) is in said end-mounted position (see figure 4); and a spacer (30) extending from said first end wall (12) in a direction away from second end wall (see figure 1), configured to abut the side surface of the stud (40) and space said first end wall (12) from the side surface stud (40) when said frame (10) is in said end-mounted condition (see figure 4).

Regarding claim 8, Bourassa discloses the bracket (10) wherein said spacer (30) is configured to abut the side surface of the stud (40) along a transversely extending line of abutment (see figure 4).

Regarding claim 9, Bourassa discloses the bracket (10) further comprising a second such spacer (30) longitudinally spaced apart from said first spacer (see figure 1).

Regarding claim 10, Bourassa discloses the bracket (10) further comprising a second such spacer (30) transversely spaced apart from said first spacer (see figure 1).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bourassa (US 5,579,939). In view of Reiker (US 5,667,512).

Regarding claim 11, Bourassa discloses an electrical bracket (10) for mounting an electrical device to a wall stud (40), said bracket (10) comprising: a rectangular frame having first (12) and second (16) opposite end walls, first (14) and second (18) opposite side walls, and a front opening (20) surrounded by said end walls (12,16) and side walls (14,18) for inserting an electrical device into said frame (10), said frame (10) having an end-mounted position (see figure 1) in which said first end wall (12) faces a side surface of the stud (40); a fastening tab (54) extending from said first end wall (12) in a direction away from said second end wall (16), configured to be fastened to a front surface of the stud (40) when said frame (10) is in said end-mounted position (see figure 4); but Bourassa lacks a side mounted position in which said first side wall faces the side surface of the stud and a fastener support configured to capture a stud-penetrating fastener that fastens said bracket to the stud when said frame is in said side-mounted position. Reiker teaches an electrical bracket (see figure 4) having a side



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mounted position in which a first side wall (66) faces the side surface of a stud (88) and a fastener support (84) extending from a first end wall in a direction away from a second end wall (see figure 4) and configured to capture a stud-penetrating fastener (82) that fastens said bracket (60) to the stud (88) when said frame is in said side-mounted position (see figure 5), said fastener support (84) having a distal end configured to contact the side surface of the stud. It would have been obvious to one of ordinary skill in the art at the time the invention was made to add to Bourassa's first end wall a fastener support extending from a first wall in a direction away from a second wall and configured to capture a stud penetrating fastener to fasten the bracket to the stud in a side mounted position as taught by Reiket to provide means to mount the bracket in two different positions.

Regarding claim 12, the modified Bourassa discloses the bracket (10) wherein said fastener support (84 of Reiker) is configured to retain the fastener (82 of Reiker) in an orientation in which the fastener extends alongside said first end wall and into the stud when said frame is in said side-mounted position (as taught by Reiker).

Regarding claim 13, the modified Bourassa discloses the bracket (10) further comprising a stabilizer (30), separate from said fastener support (as taught by Reiker), extending from said first end wall in a direction away from said second end wall (see figure 1), configured to contact the surface of the stud when said frame is in said end-mounted position to stabilize said frame from rocking about said fastener support relative to the stud (see figure 4).

Regarding claim 15, the modified Bourassa discloses the bracket (10) wherein said fastener support (84 of Reiker) and said stabilizer (80) are spaced from each other (see figure 1).

***Allowable Subject Matter***

7. Claims 7 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for allowance: The primary reasons for the indication of the allowability of claims 7 and 14 are:

Regarding claim 7 is the inclusion therein in combination as currently claimed of the limitation of said spacer being a fastener support configured to capture a stud-penetrating fastener that fastens said bracket to the stud when said frame is in a side-mounted position in which said first side wall faces the stud.

Regarding claim 14 is the inclusion therein in combination as currently claimed of the limitation of said fastener support has a groove surface, and said stabilizer is configured to urge the fastener against the groove surface to retain the fastener in said groove surface.

These limitations were found in claims 7 and 14, and are neither disclosed nor taught by the prior art of record, alone or in combination.

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**Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nix et al (US 4,724,281), Chandler et al (US 5,833,110), Callanan (US 3,724,795), Herth et al (US 5,600,093), Norberg et al (US 4,724,207), Schuldt (US 4,673,097), Rath Jr. (US 5,287,665), Hansen (US 4,140,293 and Lentz (US 4,757,158) discloses an electrical bracket for mounting an electrical device to a wall stud.


9. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (571) 272-1973. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-1984. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

AE

January 30, 2004

 2/9/04  
DEAN A. REICHARD  
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